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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,411	10/16/2000	Norberto Festo	B-3992PCT618	7180

7590

02/26/2004

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EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/673,411

**Applicant(s)**

FESTO, NORBERTO

**Examiner**

Taylor Victor Oh

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,13,15,23 and 31-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4,13,15,23,31-38, and 58 is/are allowed.
- 6) ☒ Claim(s) 39-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/2/03 &amp; 10/27/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### ***Final Rejection***

#### **The Status of Claims**

Claims 1, 4, 13-15, 23, 31-38 and 39-58 are pending.

Claims 39-57 have been rejected.

Claims 2-3, 5-12, 14, 16-22, 24-30 have been canceled.

Claims 1, 4, 13, 15, 23, 31-38, and 58 are allowable.

#### **Specification**

In the contents of the specification from line 13, page 10 to line 22, page 57, numerous active ingredients are described. The one section of the contents is exemplified as followed (see lines 13-15 page 10):

**1)  $\alpha$ -Adrenergic agonists such as** Adralinil. Adrenolone. Amidephrine.

Apraclonidine. Budralazine. Clonidine. Cyclopentamine. Detomidine.

Dimetofrine. Dipivefrin. Ephedrine. Epinephrine. Fenoxazoline.

In this section, each active ingredient is separated by the period. This is grammatically improper. Furthermore, the space between the active ingredients is not proper.

Therefore, an appropriate correction is required in the contents and the space between the active ingredients, from line 13, page 10 to line 22, page 57; of the specification .

#### **Claim Objections**

Claims 45-47, 50, and 57 are objected to because of the following informalities: In claims, some of active ingredients are separated by the period. The one section of

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claim 50 is exemplified as followed (see lines 13-15 page 10):

Arotinolol. Atenolol. Betaxolol. Bevantolol. Bisoprolol. Bopindolol.

Bunitrolol. Bupranolol. Butofilolol. Carazolol. Carteolol. Carvedilol.

Celiprolol. Cetamolol. Epanolol. Indenolol. Mepindolol. Metipranolol.

Metoprolol. Moprolol. Nadolol. Nipradilol. Oxprenolol. Penbutolol. Pindolol.

In this section, each active ingredient is separated by the period. This is grammatically improper. Furthermore, the space between the active ingredients is not proper. Appropriate correction is required.

#### **Claim Rejections-35 USC 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 40, the phrase "the active ingredient comprises Troxerutine, Nimesulide, ketoprofen, and / or Etodolic acid" is recited. This expression is vague and indefinite because the phrase "the active ingredient comprises" may mean that all the ingredients, such as "Troxerutine, Nimesulide, ketoprofen, and / or Etodolic acid", contain in the pharmaceutical composition or that only one of them may be selected

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from the group of the following active ingredients: Troxerutine, Nimesulide, ketoprofen, and / or Etodolic acid." This same kind of indefiniteness appears in claims 39 and 41-57. Therefore, an appropriate correction is required.

Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "derivatives thereof " is recited in the claim in pages 47 and 94 of Appendix K. However, the term "derivatives" is without further clarification by the specification. Therefore, an appropriate correction is required.

The rejection of Claims 1, 4, 9, 13, 15, 18-19, 23, 25-28, and 31-32 under 35 USC 112, second paragraph, has been withdrawn due to applicants' convincing argument in the amendment.

### **Claim Rejections-35 USC 103**

1. Applicants' argument filed 11/27/2003 have been fully considered and they are persuasive.

The rejection of Claims 1,3-4, 9, 13,15, 18-28, 31-32, 34-35, and 37-38 under 35 U.S.C. 103(a) as being unpatentable over Barz et al (EP 0390206) in view of Gross et al (U.S. 5,686,102) has been withdrawn due to applicants' convincing argument .

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mckane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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BA K. TRINH  
PRIMARY EXAMINER  
GROUP 1200

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